



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/879,353      | 06/12/2001  | Yasuhiro Toguri      | 450100-03281        | 3903             |

20999 7590 02/14/2003

FROMMER LAWRENCE & HAUG  
745 FIFTH AVENUE- 10TH FL.  
NEW YORK, NY 10151

EXAMINER

SLOAN, NATHAN A

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2614

DATE MAILED: 02/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PRG

**Office Action Summary**

Application No.

09/879,353

Applicant(s)

TOGURI, YASUHIRO

Examiner

Nathan A Sloan

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 November 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 25 November 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Response to Amendment*

1. Applicant's arguments filed November 25, 2002 have been fully considered but they are not persuasive. Applicant asserts that Itakura et al. (6,351,745) do not teach the amended limitation to claims 1, 6, 7, 8, and new independent claim 16 that "said contents data, said additional information, and said individual additional information are simultaneously displayed on a screen at said other apparatus." Examiner submits that Figures 29 and 34 of Itakura clearly teach this feature, and addresses this limitation in further detail with response to the amended claims below.

Independent claim 17 has been added and applicant asserts that there is no mention in *Itakura or Baji of generating individual metadata from additional data and extracted individual additional information*, making independent claim 17 patentably distinguishable from Itakura and Baji. Although the specific term "metadata" is not used by Itakura, examiner notes that applicant defines metadata to be additional information that describes audio and video data on page 1, lines 18-21. Itakura clearly teaches generation of data describing audio and video data for the purpose of updating charging information as claimed in column 10, lines 20-38.

*Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 5-7, and 16 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Itakura et al., U.S. Patent No. 6,351,745.

Itakura et al. teach a system used in a communication network that allows clients to access information internet over a broadband connection as well as receive messages such as advertisements. User preferences are stored in a user database and advertisements are sent to users based on their preferences. A billing system is also taught to charge the advertiser based on the advertisements displayed to the user.

With respect to claims 1, 5, 6, and 16, Itakura teaches the claimed information processing apparatus. The claimed first registration means for registering additional information regarding said contents data is met by Itakura's means to store data and identifying information. In column 8, lines 1-11 Itakura teaches storing data which represents the location of the data requested. Itakura further teaches storing the types of operation and user's ID in association with the said data in column 5, lines 61-66. In this manner, Itakura meets the claimed first registration of "information" regarding said contents data. Examiner notes that in the light of the specification,

Art Unit: 2614

applicant discloses that said additional information is “inherent to the common AV contents among users, e.g., an identification no., a format, a reproduction time, a storage location, a title, a genre, and a copyright” on page 3, lines 30-33. It is noted that applicant discloses this as information known to be prior art.

Furthermore, the claimed “second registration of additional individual information...” is met by Itakura in the registering of client preferences in item S414 of figure 17. User information such as sex, marriage status, occupation, etc. are stored in the message user database 34 of figure 6. As noted in examiner’s first office action, Itakura also teaches that a transmittal condition database 36 can record additional information regarding goods that the user has already shown interest in, claimed on the basis of said contents data, to ensure that suitable advertisements are sent according to user preferences in column 10, lines 48-58. As taught in column 10, lines 21-24, this database stores message URL’s that identify each message and the corresponding transmission conditions. By using the user information to find proper messages, the message URL’s are also “registered” for individual users based on preferences as “additional individual information” as claimed. The claimed storage means for storing said first and second registration information are thus met by the message user database 34 and the transmittal condition database 36. The databases also meet claim 5 by having a plurality of information regions as seen in figures 7-10.

Furthermore, the claimed extraction means for extracting said additional information and additional individual information are met by the characteristics reader used to retrieve characteristics from the databases in column 27, lines 48-49.

Art Unit: 2614

Furthermore, the claimed generation means for generating individual data to be transmitted based on the information regarding contents data and "individual additional information" is met by the message distribution apparatus 39 of figure 1. Itakura teaches receiving a request for a message, followed by the reading of user preferences from said message user database 34 and transmittal condition database 36. Based on user preferences, a message as well as a URL relating to additional information are generated as taught in column 10, lines 31-58.

Furthermore, the claimed transmission means for transmitting said contents data and additional individual information is met by Itakura in column 11, lines 60-67 and column 12, lines 1-8. Itakura teaches an internet connection with known communication method and message distribution apparatus 39 for distributing said individual data as messages to a terminal 10 of figure 1.

With respect to displaying said contents data, additional information, and individual additional information *simultaneously*, examiner refers applicant to Figures 29 and 33. As seen in Figure 29 and 33 a contents data region 60 is shown, a "Location region" is shown for displaying the claimed "additional information regarding said contents data," a message viewer window 62 exists to display claimed "individual additional information," which is retrieved as noted above using user database 34 and transmittal condition database, and a Home Page button 64 is shown for showing additional information regarding the individual data. Furthermore, examiner notes that within the message viewer region 62 a home page button 64 exists to direct a user to the location of the individual additional information displayed in message viewer window 29, and a material request button 66 exists to request more information regarding individual data

Art Unit: 2614

displayed in message viewer window 62. Clearly it can be seen from Figure 29 and 33 that all of these elements are display simultaneously as claimed. In response to the applicants assertion that “the Web address is displayed after the message is ‘clicked’ on,” examiner notes that applicants claim specifically cites the limitation “extracting said additional information and said individual additional information *if a delivery request* is received from said other apparatus.” The claimed “request” is met by the “clicking” as taught by Itakura and noted by applicant. The information is then claimed to be generated, met as noted above, and finally a “transmission step of transmitting said individual data generated by the processing of said generation step, together with said contents data ... to enable said contents data, said additional information, and said individual information to be simultaneously displayed on a display screen at said other apparatus” is claimed. As taught in column 9, lines 18-21, a material request button 66 is used by a viewer to *request* additional information regarding goods advertised, and this information is then displayed in the message viewer window 62. At this time the display in Figure 29 *simultaneously* shows, the contents data in window 60, location of contents data under “Location,” location of individual additional information through Home Page button 64, and individual additional information in message window 62. Clearly the transmission step as claimed is *after a delivery request* which is clearly taught by Itakura with clicking on the message viewer for additional information.

With respect to claim 2, the claimed means for recording charging information on the basis of individual data generated is met by Itakura in the message access log 37 as seen in figure 12. Itakura teaches recording information regarding the access of said individual information data in column 1, lines 9-21.

Art Unit: 2614

With respect to claim 7, the claimed recording medium wherein a program for controlling an information processing apparatus to deliver data over a network is taught by Itakura in the message manager 24. Itakura teaches message viewer software 76 of figure 3 to be installed on the terminal device in a recording medium in column 8, lines 43-67 and column 9, lines 1-3.

Itakura further teaches that the recording medium can be a variety of devices such as RAM, DVD's, floppy disks, CD-ROM, tap media, semiconductor memory, etc in column 25, lines 5-24. The software in the terminal device is used to communicate with message manager 24 of figure 1 over the internet. The message manager is taught to send and receive messages with the terminal as well as access databases. In this manner the message manager meets the claimed program because it controls the processing of all limitations set forth and addressed in claim 6.

With respect to the amended additional limitation that "said contents data, individual information, and individual additional information are simultaneously displayed on a display screen at said other apparatus," these features are taught as seen in Figures 29 and 34 and noted in response to claim 1.

With respect to claim 17, Itakura teaches delivering messages and additional information to users based on their viewing history, as well as charging message providers in response to the delivery of the messages. As noted above, Itakura teaches receiving a request for a message, followed by the reading of user preferences from said message user database 34 and transmittal condition database 36. Based on user preferences, characteristics including status, and usage history as seen in Figures 7, 8, and 9, claimed user status and classification, the messages suitable for individual viewers are generated. This general purpose additional information is displayed in the message viewer window 62 and as well as a URL link through home page



Art Unit: 2614

button 64, and a material request button 66. In response to applicant's assertion that there is no mention of generating individual metadata from additional data and extracted additional information in the Itakura reference, although the specific term "metadata" is not used, the generation of individual metadata from additional data and extracted additional information is taught. Examiner notes that applicant defines metadata as additional information that describes audio and video data on page 1, lines 18-21. This information is taken as commonly defined in the industry to include information such as name, size, data type, length, location, ownership, associations, and a number of other factors that describe contents data. As seen in Figures 11 and 12, a record is formed with information describing the extracted information including a note as to whether material requests are made. This information is taught to be used to "update charging information on the basis of said generated individual metadata," in column 10, lines 20-38. The claimed transmission of contents data and individual metadata, information describing the audio video contents data, is met as noted above with the transmission of contents data in window 60, messages in message window 62, and URL link to the homepage 64 of Figure 29. Examiner further notes in column 9, lines 18-24 it is taught that if the user selects material request button 66 informational materials describing the audio or video advertisement are displayed in window 62.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2614

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3, 4, 8, 10, 12, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Itakura as applied to claims 1, 2, and 5-7 above, and further in view of Baji et al., U.S.

Patent No. 5,027,400.

With respect to claims 3, 4, 10, 12, and 14 all of the limitations that are reflected in claim 1 as addressed above. Itakura does not teach the first registration means registering information by splitting the contents of data per segment, scene, or object. Furthermore, Itakura teaches the second registration means registering individual additional information with URL addresses but not split per segment, scene, or object as claimed. Baji teaches a cable distribution network used to transmit regular programming as well as commercials, claimed additional information, in a television broadcast. Baji explicitly teaches the transferring of desired program and advertisement to the main controller 106 of the head end in column 4, lines 13-17. The main control program then controls the integration of the advertisements with the regular programming, splitting the regular programming up as in claim 3 of applicant and inserting commercial or advertisement scenes as in claim 4 of applicant. The table and method for controlling this process is shown in figure 10 and taught in column 7, lines 46-65. Examiner notes that it is well known in the industry to split up television programs, whether viewed over conventional television or via Internet broadcast, up into scenes with commercials show in between. Furthermore, Itakura teaches in column 9, lines 10-13 that the message viewer may display a new message every predetermined time interval, and the simultaneous display of this message as noted in response to claim 1. Baji similarly teaches splitting a television program

Art Unit: 2614

with registered commercials at predetermined time intervals as seen in Figures 5A-5P, which splits the program per segment or scene as claimed. It clearly would have been obvious for one skilled in the art at the time to modify the simultaneous displaying of contents data and additional advertising information taught by Itakura by the data stream splitting techniques of Baji in order to integrate advertisements with the regularly viewed content.

With respect to claim 8, Itakura teaches the first apparatus, including the amended limitation of displaying "said contents data, individual information, and individual additional information simultaneously on a display screen at said other apparatus," as addressed in response to claim 1 above. Although Itakura teaches receiving and processing a request for data to be transmitted, Itakura does not teach a *second apparatus* having delivery request means so as to transfer said contents data to said first apparatus. Itakura also does not teach an output means for *integrating* said contents data and said individual data supplied from the first apparatus. Baji teaches a main control unit 106 for controlling the access of contents data and additional individual data. Baji further teaches a second information apparatus the terminal control unit 113 of figure 1 to be used in conjunction with a delivery request. The commercials may be integrated into the regular contents data by storing commercials in a buffer on the terminal control unit and then integrating them into the regular content data in column 8, lines 30-48. In this manner, Baji teaches a delivery request for contents data by the main control unit, claimed first apparatus, and output means in the terminal unit, claimed second apparatus, for integrating the contents data and individual data. It would have been obvious for one skilled in the art at the time to modify the targeted advertisement apparatus of Itakura with the second apparatus of in order to integrate advertisements with regularly viewed content for the user.

Art Unit: 2614

5. Claims 9, 11, 13, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Itakura et al. (6,351,745) and Baji (5,027,400), and further in view of Kitsukawa et al. (6,282,713).

With respect to claims 9, 11, 13, and 15 neither Itakura nor Baji explicitly teach splitting registration per object appearing within said contents data. Examiner notes that the use of "hot spots" is well known in the art, and that these systems would read on many of the limitations of claim 1. Hot spots are used to allow the viewer to obtain additional information regarding items in a display. A display is split per object based on items, claimed additional information, with additional individual information consisting of a URL link that provides additional information about the item appearing in within the display. To these means, Kitsukawa et al. (6,282,713) teach an electronic advertising system utilizing hot spots to link users to additional information regarding displayed products. As seen in Figure 5, items containing additional information are separated per object and URL information, claimed individual additional information, is registered for each item. As seen in Figure 4, item 410, a user may select an item, claimed "request," and as taught in column 7, lines 34-40 the full advertisement or web link may be displayed simultaneously with the regularly playing programming using well known picture in picture techniques. It would have been obvious for one skilled in the art at the time of the invention to further modify the techniques taught by Itakura and Baji by splitting additional information per object as taught by Kitsukawa in order to provide additional information relating to multiple items displayed in a program that the user may have interest in.

*Conclusion*

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Chaddha et al. (6,173,317) teach a system used to display video streams with embedded data including URL addresses pointing to web pages.

Hite et al., U.S. Patent No. 6,002, 393, discloses a system and method for targeting tv advertisements to users based on individual consumer habits.

Gardenswartz et al., U.S. Patent No. 6, 055, 573, discloses a system, method, and computer program for delivering a targeted advertisement. Gardenswartz incorporates a registration server to setup user preferences and track consumers with the use of cookies.

Angles et al., U.S. Patent No. 6, 385, 592c discloses an interactive communication system used to deliver advertisements based on personal user profiles. Angles also discloses advertisement, accounting, and registration databases used to link user preferences to advertisements and charge the provider based on advertisement viewing.

Sawyer, U.S. Patent No. 6, 084, 628, discloses a targeted telecommunications advertisement system comprising a central advertisement database.

Dedrick, U.S. Patent No. 5, 724, 521, discloses an electronic advertisement system having a consumer scale associated with advertisements that match user preferences existing in a user profile database.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan A Sloan whose telephone number is (703)305-8143. The examiner can normally be reached on Monday through Friday from 7:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller, can be reached on (703) 305-4795. The fax phone number for the organization where this application or proceeding is assigned is (703)308-5399.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-3900.

  
**JOHN MILLER**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2600**